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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/728,163	12/04/2003	Michael Wayne Brown	AUS920030868US1	6780
43307	7590	11/02/2007		
IBM CORP (AP) C/O AMY PATTILLO P. O. BOX 161327 AUSTIN, TX 78716			EXAMINER LEE, JOHN J	
			ART UNIT 2618	PAPER NUMBER
			MAIL DATE 11/02/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

10/728,163

**Applicant(s)**

BROWN ET AL.

**Examiner**

JOHN J. LEE

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 25 August 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) 30-36 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-8,10-13,15-19,21-24 and 26-29 is/are rejected.
- 7) ☒ Claim(s) 3,9,14,20 and 25 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>12/4/03, 11/3/05</u> | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Election/Restrictions*

1. Applicant's election without traverse of group I (claims 1-29) in the reply filed on 8/25/2007 is acknowledged.

### *Specification*

2. The disclosure is objected to because of the following informalities: It is required to fill the blanks with proper US patent Application Serial number in page 1.  
Appropriate correction is required.

### *Claim Rejections - 35 USC § 101*

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. **Claims 23-29** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Regarding **claims 23-29**: the limitation "A computer program product" is not patentable since the limitation does not fall under one of the statutory categories such that process, machine, manufacture or composition of matter.

The preamble of the claims 23-29 must start out as "a computer readable medium encoded with a computer program" or "a computer readable medium having a stored computer program".

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. **Claims 1, 2, 4-8, 10-13, 15-19, 21-24, and 26-29** are rejected under 35 U.S.C. 103(a) as being unpatentable over Pou et al. (US 2005/0004873) in view of Costello et al. (US 2002/0184038).

Regarding **claims 1, 12, and 23**, Pou teaches that a method for controlling access to wirelessly broadcast electronic works during playback (pages 6, paragraphs 63 - 64 and Fig. 3, 8). Pou teaches that receiving a wireless broadcast of an electronic work with digital rights rules from a primary player at a secondary player (pages 12, paragraphs 101 - 104 and Fig. 8, where teaches a secondary device receives the media files including business rules, instructions, license information, digital content from the user device (primary device)). Pou teaches that storing a sample of said electronic work with digital rights rules at said secondary player (pages 12, paragraphs 103 - pages 13, paragraphs 107 and Fig. 8, where teaches the secondary device stores a sample files (pre-installed solution software) with license information). Pou teaches that responsive to detecting said secondary player reception range of said primary player (Fig. 8 and pages 12, paragraphs 103 - pages 13, paragraphs 107, where teaches the primary device (user device) transfers the media files to secondary device which is within coverage area), only allowing

playback of said stored electronic work according to said digital rights rules (pages 12, paragraphs 103 – pages 13, paragraphs 107 and Fig. 8, where teaches the secondary device get a permit by using business rules and license information to play media information such that songs).

Pou does not specifically teach the limitation “detecting said secondary player outside reception range of said primary player, only allowing playback of said stored electronic work”. However, Costello teaches the limitation “detecting said secondary player outside reception range of said primary player, only allowing playback of said stored electronic work” (pages 10, paragraphs 116 – 117 and Fig. 1, where teaches detecting the broadcasting signal at the receiver in new geographic area to playback of the stored media). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the Pou’s system as taught by Costello, provide the motivation to enhance controlling and providing the broadcast media to the devices for outside coverage area.

Regarding **claims 2, 13, and 24**, Pou teaches that enabling synchronous play of said electronic work at said secondary player while said secondary player is within reception range of said primary player (Fig. 8 and pages 2, paragraphs 21 – 22).

Regarding **claims 4, 15, and 26**, Pou teaches that wirelessly transmitting electronic work preferences of at least one user of said secondary player to said primary player, such that said broadcast electronic work is selected based on said electronic work preferences (Fig. 9 and pages 13, paragraphs 108 – 110).

Regarding **claims 5, 16, and 27**, Pou teaches that recording a rating by at least one user of said secondary player, responsive to playback of said electronic work (pages 6, paragraphs 63 – pages 7, paragraphs 65 and Fig. 3, 8).

Regarding **claims 6, 17, and 28**, Pou teaches that receiving said broadcast of said electronic work, wherein said digital rights rules allow broadcast of said electronic work by said primary player (pages 12, paragraphs 101 – pages 13, paragraphs 107 and Fig. 8, where teaches the secondary device get a permit by using business rules and license information to play media information such that songs).

Regarding **claims 7 and 18**, Pou teaches that storing said broadcast of said electronic work with said digital rights rules at said secondary player, wherein said digital rights rules allow for broadcast of said electronic work by said secondary player (pages 12, paragraphs 101 – pages 13, paragraphs 107 and Fig. 8).

Regarding **claims 8 and 19**, Pou teaches that for controlling access to wirelessly broadcast electronic works during playback wherein said electronic work is one from among a musical work, a textual work, a video work, and a film work (pages 12, paragraphs 101 – pages 13, paragraphs 107 and Fig. 8).

Regarding **claims 10 and 21**, Pou teaches that receiving a context for said electronic work during said wireless broadcast of said electronic work (pages 2, paragraphs 13 – 18 and Fig. 8) and only enabling presentation of said context via an output interface of said secondary player according to said digital rights rules for said electronic work (pages 12, paragraphs 101 – pages 13, paragraphs 107 and Fig. 8).

Regarding **claims 11, 22, and 29**, Pou teaches that receiving said wireless broadcast of an electronic work with context data from a primary player at a secondary player (pages 12, paragraphs 101 – pages 13, paragraphs 107 and Fig. 8) and only allowing output of said context data according to said digital rights rules (pages 12, paragraphs 101 – pages 13, paragraphs 107 and Fig. 8).

***Allowable Subject Matter***

7. Claims 3, 9, 14, 20, and 25 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The prior art of record fails to disclose “prompting a user at said secondary player to select at least one from among a synchronous playback of said electronic work and storage of said sample of said electronic work, and the digital rights rules are one from among a license to wirelessly broadcast said electronic work, a license to playback said sample of said electronic work a particular number of times, a license to playback only a portion of said sample of said electronic work, a license to playback said sample of said electronic work under a degraded quality, a license to playback said sample of said electronic work after a decryption key is obtained, a license to display context about said electronic work, and a license to display reviews of said electronic work” as specified in the claims.

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***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Edmonson et al. (US 2006/0053080) discloses Centralized Management of Digital Rights Licensing.

Janik et al. (US 2007/0178830) discloses Storage and Playback Device and Method for Using the Same.

Information regarding...Patent Application Information Retrieval (PAIR) system... at 866-217-9197 (toll-free)."

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks  
Washington, D.C. 20231  
Or P.O. Box 1450  
Alexandria VA 22313

or faxed (571) 273-8300, (for formal communications intended for entry)

Or: (703) 308-6606 (for informal or draft communications, please label "PROPOSED" or "DRAFT").

Hand-delivered responses should be brought to USPTO Headquarters, Alexandria, VA.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **John J. Lee** whose telephone number is **(571) 272-7880**. He can normally be reached Monday-Thursday and alternate Fridays from 8:30am-5:00 pm. If attempts to reach the examiner are unsuccessful, the examiner's supervisor,



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**Edward Urban**, can be reached on (571) 272-7899. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-4700.

J.L

October 26, 2007

John J Lee

A handwritten signature in black ink, appearing to read "John J Lee", with a long horizontal flourish extending to the right.